

REMARKS

Claims 1-17 are pending in the application. Claims 1-17 are rejected. Claims 1, 7 and 11 are herein amended. Claims 2, 8, 12 and 15-17 are herein canceled.

Objections to the Disclosure

The disclosure is objected to because the use of trademarks, e.g., Scotch™ mending tape at page 29, line 25, has been noted in this application. Applicants herein amend the specification to correct the errors.

Rejections under 35 U.S.C. §112, first paragraph

Claims 1-17 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that was not described in the specification as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed. The Examiner notes that the claims recite a polyester resin comprising a first crosslinked polyester resin having a softening point Tsp of not lower than 120°C and lower than 170°C, and a second “non-crosslinked polyester resin” having a Tsp of not lower than 80°C and lower than 110°C. The Examiner asserts that the originally filed specification does not provide an adequate written description of the generic second “non-crosslinked polyester resin” recited in the instant claims.

The Examiner asserts that the second “non-crosslinked polyester resin” recited in the instant claims is broader than the disclosed “second non-linear polyesters,” because the originally filed

specification does not disclose that the second non-linear polyester is a non-crosslinked polyester resin as recited in the instant claims.

Applicants note that an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Applicants submit one skilled in the art would realize that the description of the non-crosslinked polymer as “non-linear” was an error, and would realize that the error was in calling the second polymer “non-linear”. Applicants submit herewith a Declaration by a person skilled in the art, which indicates that the Declarant, upon reading the specification, both easily recognized that an error was apparent, and also easily recognized what the correct meaning should have been.

Rejections under 35 U.S.C. §103(a)

Claims 1, 3/1, 4/3/1, 5/1, and 6/1 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,232,029 B1 (Kushino ‘029) combined with U.S. Patent No. 6,361,914 B1 to Semura and Japanese Patent 2000-075544 (JP ‘544). The Examiner concludes that it would have been obvious in view of the teachings of Semura and JP ‘544 to make a crosslinked polyester resin obtained from the alcohol and acid components in the amounts taught by Semura, such that the resulting crosslinked polyester resin has a softening point of 130 to 145°C and a chloroform-insoluble content of 10 wt% as taught by JP ‘544, and to use said crosslinked polyester resin in combination with either Semura’s non-crosslinked polyester resins B or C, as the toner binder resin in the toner disclosed by Kushino ‘029.

Claims 7, 9/7, 10/9/7, 11, 13/11, and 14/13/11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kushino '029 combined with Semura and JP '544 as applied to claims 1, 3/1, 4/3/1, 5/1, and 6/1, above, further combined with Diamond, Handbook of Imaging Materials, pp. 160-163. The Examiner concludes that it would have been obvious for a person having ordinary skill in the art, in view of the teachings of Kushino '029 and Diamond, to use the flash fixing electrophotographic toner allegedly rendered obvious by the combined teachings of Kushino '029, Semura and JP '544 in the electrophotographic imaging process and apparatus comprising the steps and components recited in instant claims 7 and 11, because of an expectation of successfully obtaining an electrophotographic imaging process and copying apparatus that provide color toner images adequately fixed to image receiving material without voids and fog as taught by Kushino '029, Semura, and JP '544.

Applicants herein amend the claims, and subsequently submit that all the claimed limitations are not taught or suggested by the cited references. Applicants note that the Examiner did not substantively reject claims 2, 8 and 12, which recite specific acid values. In particular, claims 2, 8 and 12 recite an acid value of the first polyester resin is from 20 to 40, an acid value of the second polyester resin is from 5 to 20, and an acid value of the entire polyester resin is from 15 to 35. Applicants herein import these limitations into claims 1, 7 and 11, subsequently canceling claims 2, 8 and 12. Applicants respectfully submit that the rejection of the claims under 35 U.S.C. §103 has been overcome.

U.S. Patent Application Serial No. 09/935,668

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are patentably distinguished from the cited references, and are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees that may be due with respect to this paper to Deposit Account No. 01-2340.

Respectfully submitted,

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Enclosures: Petition for Extension of Time
Declaration

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